

REMARKS

Claims 1-31, and 37-43 are pending in the application. Claims 32-36 have been canceled. Claims 38-43 have been added. Claims 1, 11, 13, 19, and 25 have been amended. Favorable reconsideration of the application, as amended, is respectfully requested.

I. INFORMATION DISCLOSURE STATEMENT

The post card submitted herewith, of which mailing date is January 22, 2002, indicates that 23 references have been received by the PTO on January 31, 2002. However, to expedite the prosecution, Applicants hereby resubmit a copy of documents C1, C2, C3, C4, and C6. Applicants respectfully request the Examiner to consider these documents, and provide Applicants with a signed 1449 form.

II. CLAIM OBJECTION

Claim 37 is objected to as being dependent from claim 30, and separated by claims not dependent from claim 30. Claims 32-36 have been canceled, and new claims 38-42, which correspond to originally filed claims 32-36, respectively, have been added. Therefore, Applicants believe that these amendments are sufficient to address the Examiner's concern. Withdrawal of the objection is respectfully requested.

III. REJECTIONS OF CLAIMS 1-37 UNDER 35 U.S.C. §§ 102 AND 103

Claims 1-2, 4, 6, 8-10, 13-14, 16-20, 22-28, and 30-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,449,250 ("Otani"). Claims 3, 5, 7, 15, 21, 29, and 32-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Otani in view of U.S. Patent No. 6,438,123 ("Chapman"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,835,696 ("Hess") in view of Chapman. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hess in view of Chapman, and further in view of U.S. Patent No. 5,572,528 ("Shuen"). Applicants believe that all pending claims are allowable for at least the following reasons. Withdrawal of the rejections is respectfully requested.

Independent claims 1, 11, 13, 19, and 25 have been amended to further clarify one of the aspects of the invention. Specifically, independent claim 1 requires "prior to the working CMTS becoming unavailable, assuming a protection state in which the protection CMTS can take over service of the cable modem should its service with the working CMTS become unavailable." Independent claims 11, 13, 19, and 25 contain the substantially the same limitations as those recited in independent claim 1. Claim 43 is a means plus function claim, which corresponds to claim 1. Support for the amendments is found at, for example, page 10, lines 16-24; page 11,

lines 26-32; and page 13, lines 7-21 of the present specification. No new matter has been introduced by these amendments.

As described at, for example, page 10, lines 16-24; page 11, lines 26-32; and page 13, lines 7-21 of the present specification, the invention defined in independent claims 1, 11, 13, 19, 25, and 43 is directed to pre-registration of a cable modem with a protection CMTS. For example, a specific exemplary embodiment of the invention involves a modified registration process, in which a cable modem pre-registers with a protection CMTS, and the protection CMTS remains in a protection state ready to take over service to the cable modem when the working CMTS becomes unavailable.

The Otani patent generally relates to switching a plurality of central devices. However, nothing in Otani suggests the claimed pre-registration with a protection CMTS. As described at column 4, lines 60-65 of Otani, it is only after a failure occurs on the device 10 that the protection device inherits the IP and MAC addresses of the segment R0. See also, Fig. 1 of Otani. Therefore, Otani cannot be said to teach or suggest the above-identified claimed feature of the invention of claims 1, 13, 19, 25, and 43.

The Hess patent describes a system with routers, each of which includes an active port, and a standby port. According to the description cited by the Examiner (column 2, line 45 - column 3, line 5 of Hess), a standby port of two routers 10-1 and 10-2 sends a heart beat message to a corresponding active port. However, throughout the description of Hess including this description, there is nothing to suggest pre-registration of a cable modem. Thus, Hess fails to teach or suggest the claimed feature recited in claim 11.

The Chapman patent was cited as describing a voice over internet protocol (VoIP) application. However, Chapman is silent on the claimed pre-registration aspect of the invention. As such, Chapman does not make up the deficiencies of Hess.

In summary, Applicants find nothing in the prior art that suggests the claimed pre-registration feature as recited in independent claims 1, 11, 13, 19, 25, and 43. If the Examiner believes that such a prior art exists, Applicants respectfully request that such art be identified so that they can make a meaningful assessment of its impact on patentability of independent claims 1, 11, 13, 19, 25, and 43.

Regarding claim 38, the Examiner cited Otani and Chapman as describing the features recited in originally filed claim 32, which corresponds to current claim 38. As the Examiner concedes in the Office Action, Otani fails to disclose a cable modem which is configured to store registration data including parameters for both a working CMTS and a protection CMTS as recited in claim 38. Chapman describes a cable modem containing multiple service identifiers

(SIDs). However, as described at column 8, lines 8-14, Chapman's multiple SIDs correspond to multiple microflows 80 and other types of data. In other words, these SIDs are not relevant to working and protection CMTSs in any way. In addition, Chapman is not concerned with taking over service to a cable modem when a working CMTS becomes unavailable. Therefore, the mere fact that Chapman allegedly shows multiple SIDs stored in a cable modem does not render the invention obvious since there is no suggestion to modify Chapman's cable modem so that it contains parameters for a working CMTS and a protection CMTS.

Any asserted suggestions must be *reasonable* to one of skill. Further, in order for an invention to be obvious, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification. Here, even assuming *arguendo* that Chapman shows storing multiple SIDs, neither Chapman nor Otani teaches or suggests how these SIDs are tied with the working and protection CMTSs. In other words, nothing in the references motivates those skilled in the art to store "separate parameters for communicating with the working CMTS and with the protection CMTS" as recited in claim 38. Thus, claim 38 is patentable over the cited art.

IV. CONCLUSION

Applicants believe that all pending claims are in condition for allowance, and respectfully request a Notice of Allowance at an early date. If the Examiner still has any continuing rejection to the application, please telephone the undersigned at 510-843-6200.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP



Haruo Yawata
Limited Recognition under 37 CFR § 10.9(b)

P.O. Box 778
Berkeley, CA 94704-0778
Tel: 510-843-6200